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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/502,875	02/11/00	MARTIN J	10527US15

TM02/0208

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EXAMINER	
HEWITT II,C	
ART UNIT	**PAPER NUMBER**
2161	8

DATE MAILED: 02/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/502,875	MARTIN ET AL.	
	Examiner	Art Unit	
	Calvin L Hewitt II	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 February 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *27-53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5 and 6* .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

Status of Claims

1. Claims 27-53 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 29 and 50 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 29 and 50 recite the presentation of song selections as being derived by, "... at least two of song genre, song artist and song title associated with each digitized song", however, such a process is not supported by the Applicants' specification. It is unclear exactly how one of ordinary skill in the art would construct such a system. The word "determine" seems to be in conflict with what the Applicant regards, as in figure 5 and pages 12, 13 and 17-19, as a song selection process. In claims 29 and 50, the Applicant appears to be describing a process where the computer is "intelligently" (e.g.

expert system) retrieving data based on a minimum search requirement in order to present data to a user. It seems natural that a desired song is retrieved from the catalog based on "song title". Or, if a specific title is not known, a search can be performed, perhaps, by artist, album title or record label, which is more in line with the Applicants' specification.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 27, 35, 41 and 48 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of prior U.S. Patent No. 5,781,889. This is a double patenting rejection.

As per claims 27, 35, 41 and 48, the claims in U.S. Patent No. 5,781,889 discloses a computer jukebox network with computer jukeboxes and central management system comprising:

- plurality of computer jukeboxes (claim 7, column 9, lines 39-50; claim 11, column 10, lines 56-59)
- a central management system (claim 7, column 10, line 25)
- a communication interface for receiving a digitized song and song identity information (claim 1, column 8, lines 28-30; claim 7, column 10, lines 25- 41; claim 8, column 10, lines 41-45; claim 13, column 12, lines 7-10)
- a memory for storing song data, such as play count, and identity (claim 1, column 8, lines 30-33; claim 7, column 9, lines 39-57; claim 7, column 10, lines 29-37claim 11, column 10, lines 55-60)
- a display presenting song selections based on song id (claim 1, column 8, lines 34-37; claim 7, column 9, lines 58-61)

- a song selector (claim 1, column 8, lines 38-42; claim 7, column 9, lines 39-50 and 62-66)
- an audio speaker (claim 1, column 8, line 44; claim 7, column 9, line 67)
- a processor to store and enable song selection (claim 1, column 8, lines 45-65; claim 7, column 10, lines 5-24 and 27-40)
- a digital to analog converter (claim 1, column 8, line 45; claim 7, column 10, lines 2-5).

As per claims 28, 36 and 49, the claims in U.S. Patent No. 5,781,889 discloses digitized song libraries and song catalogs (claim 7, column 9, lines 39-57 and column 10, lines 26-37).

As per claims 29 and 50, the claims in U.S. Patent No. 5,781,889 discloses display means and for generating a signal representing the song selected by the user (claim 7, column 9, lines 39-67).

As per claim 32, the claims in U.S. Patent No. 5,781,889 discloses the displaying of graphics associated with a song that are used to attract customers (claim 1, column 8, lines 34-37; claim 4, column 9, lines 13-19; claim 7, column 9, lines 55-61).

As per claims 33, 34, 44, 45 and 52, the claims in U.S. Patent No. 5,781,889 provides for the creation of song play counts and money intake data as well as the relaying of said data to a remote accounting location (claim 1, column 8, lines 48-65;

claim 2, column 9, lines 5-7; claim 6, column 9, lines 28-38; claim 8, column 10, lines 41-45; claim 11, column 10, lines 56-67; claim 13).

As per claim 37, the claims in U.S. Patent No. 5,781,889 discloses a central management system that stores and transmits song id and associated graphic data (claim 1, column 8, lines 34-37; claim 3, column 9, lines 8-13; claim 7, column 9, lines 55-61).

As per claims 38 and 43, the claims in U.S. Patent No. 5,781,889 discloses a central management system to receive play count and money intake data from a computer jukebox (claim 2, column 9, lines 1-7; claim 6, column 9, lines 27-38; claim 7, column 10, lines 25-40; claim 11, column 10, lines 56-67; claim 13, column 12, lines 1-10).

As per claims 40, 42 and 53, the claims in U.S. Patent No. 5,781,889 discloses a process for determining whether a song should be replaced based on song usage data and the updating of the jukebox song library (claim 1, column 8, lines 58-65; claim 2, column 8, lines 65-67 and column 9, lines 1-7; claim 12, column 11, lines 1-8).

5. Claim 30, 31, 47 and 51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-13 of U.S. Patent No. 5,781,889 in view of Korn et al. U.S. Patent No. 4,766,581.

As per claims 30, 31, 47 and 51, the claims in U.S. Patent No. 5,781,889 teaches user song selection (claim 1, column 8, lines 22-27, 33-37 and 49-65). However, claims 1-13 describe song selections arranged alphabetically or scrolling of data on the display. Korn et al. disclose song data being in alphabetical order (column 17, lines 20-32) and

scrolling means view data (column 21, lines 43-67). Therefore, it would have been obvious for one of ordinary skill in the art to combine the teachings of Korn et al. and U.S. Patent No. 5,781,889. By arranging the data alphabetically or numerically a user can visually filter through the presented data in a systematic way without undue strain. Also, by allowing a user to "scroll" the selections, the system can retrieve and display larger amounts of data thus providing for a more efficient system. Otherwise, if the data couldn't fit on the screen the system would have to display the data on separate "pages" or reduce the font in order to confirm with the screen-size requirements.

6. Claim 39 and 46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,781,889 in view of McConnell, U.S. Patent No. 4,232,295.

As per claims 39 and 46, the claims in U.S. Patent No. 5,781,889 discloses the storage of song usage data (claim 11, column 10, lines 56-67). However, claims 1-13 do not disclose royalties. McConnell teaches a jukebox polling system that allows jukeboxes to meet the mandatory requirement that a coin-operated phono-record player must pay a royalty fee to a copyright owner (column 1, lines 13-26). Further, McConnell provides a central station that is used in determining the allocation of royalty fees (abstract, lines 7-14). Therefore, it would have been obvious for one of ordinary skill in the art to combine the teachings of McConnell and U.S. Patent No. 5,781,889. Through the use of a central computer a jukebox operator can provide a market research organization (for example)

with data from a plurality of computers and thus provide for efficient and proper distribution of royalty fees.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Glick et al. teach a computing and multimedia entertainment system

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The examiner can normally be reached on Monday-Friday from 8:30 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to"

Commissioner of Patents and Trademarks

C/o Technology Center 2700

Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

or:

(703) 308-5397 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Calvin Loyd Hewitt II

January 31, 2001

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100